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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

GILLIGAN, CHRISTOPHER L

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 08/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/844,102

Applicant(s)

COLBURN ET AL

Examiner

Luke Gilligan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/20/02.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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Claims 1-17 have been examined.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

3. For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

4. In the present case, claim 1 only recites an abstract idea. The recited steps of merely reviewing a workers' compensation claims management process and amending the workers' compensation claims management process does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to implement the best practices into a workers' compensation claims management process.

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5. In addition, claim 6 only recites an abstract idea. The recited steps of merely conducting an interview, determining whether a claim is classified as high risk, and monitoring a claim does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to investigate a claim.

6. Claims 2-5 and 7-17 also fail to solve the deficiencies of independent claims 1 and 6 because they, similarly, do not does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper.

7. Although the recited process does produce a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 1-17 are deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1-3, 5-9, 12-13, and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Fernberg, **Charting a course toward lower workers' comp claims** (hereinafter Fernberg, paragraphs numbered by Examiner).

10. As per claim 1, Fernberg discloses a method of optimizing a workers' compensation claims management process, which contains files relating to a workers' compensation claim of an injured or ill individual comprising the steps of: reviewing the workers' compensation claims

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management process to determine if best practices are being followed (see paragraphs 22 and 23, in particular, the disclosed consulting and benchmarking are types of reviewing to determine best practices); amending the workers' compensation claims management process by implementing the best practices into the workers' compensation claims management process (see paragraph 24).

11. As per claim 2, Fernberg discloses the method of claim 1 as described above. Fernberg further discloses monitoring the amended workers' compensation claims management process to determine if the best practices are being followed (see paragraph 25, in particular the continuous reevaluation of the program); and closely monitoring a specific case within the workers' compensation claims management process to determine if the best practices are not being followed (see paragraphs 28-30).

12. As per claim 3, Fernberg discloses the method of claim 1 as described above. Fernberg further discloses the best practices at least includes that a report must include all known facts (see paragraph 29, it is noted that the claim only requires one or more of the listed items).

13. As per claim 5, Fernberg discloses the method of claim 1 as described above. Fernberg further discloses the best practices at least includes timely and appropriate assignment of light duty work (see paragraph 36, in particular, the Examiner is relying on the disclosure of the modified duty program).

14. As per claim 6, Fernberg discloses a method of optimizing a workers' compensation claims management process, which contains files relating to a workers' compensation claim of an injured or ill individual comprising the steps of: conducting a three point interview within 72 hours of an injury (see paragraphs 28-31, in particular, the Examiner notes that Fernberg discloses conducting interviews with the employee, supervisor, and medical provider and discloses that it is favorable to conduct reporting within 48 hours); determining whether a claim

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is classified as a high risk (see paragraphs 34 and 38, in particular, determining whether there is potential for fraud is a type of "high risk" claim); and monitoring a claim at periodic intervals (see paragraph 35).

15. As per claim 7, Fernberg discloses the method of claim 6 as described above. Fernberg further discloses determining whether a claim is classified as high risk includes asking an injured employee a plurality of questions (see paragraphs 28 and 31, the Examiner notes that gathering information through questioning employees is a part of the process of determining the potential for fraud).

16. As per claim 8, Fernberg discloses the method of claim 6 as described above. Fernberg further discloses determining whether a claim is classified as high risk includes asking a supervisor a plurality of questions (see paragraphs 28 and 31, the Examiner notes that gathering information through questioning supervisors is a part of the process of determining the potential for fraud).

17. As per claim 9, Fernberg discloses the method of claim 6 as described above. Fernberg further discloses determining whether a claim is classified as high risk includes asking a medical professional a plurality of questions (see paragraphs 28 and 31, the Examiner notes that gathering information through questioning medical professionals is a part of the process of determining the potential for fraud).

18. As per claim 12, Fernberg discloses the method of claim 9 as described above. Fernberg further discloses the plurality of questions at least includes what is your current treatment plan for the employee (see paragraph 31, in particular, the Examiner is referring to the evaluation of what the employee can do while recovering and rehabilitating).

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19. As per claim 13, Fernberg discloses the method of claim 7 as described above. In addition, claim 13 recites substantially similar additional limitations to those already addressed in claims 1 and 2 and, as such, is rejected for similar reasons as given above.

20. As per claim 15, Fernberg discloses the method of claim 7 as described above.

Fernberg further discloses closely monitoring a specific case within the workers' compensation claims management process to determine if the best practices are not being followed if the claim is classified as high risk (see paragraphs 28-30, it is noted that Fernberg discloses closely monitoring all claims and, therefore, also discloses closely monitoring "high risk" claims).

Claim Rejections - 35 USC § 103

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fernberg,

Charting a course toward lower workers' comp claims in view of Hammond et al., U.S.

Patent No. 5,712,984.

23. As per claim 4, Fernberg discloses the method of claim 1 as described above. Fernberg does not explicitly disclose the listed best practices. Hammond teaches a method for funding workers' compensation losses that at least includes the practice of properly documenting reserve changes within a file and reserve history (see column 14, lines 27-46). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the method disclosed by Fernberg. One of ordinary skill in the art would have been

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motivated to incorporate this feature for the purpose of enhancing the ability of insurers and employers to more accurately budget and forecast (see column 2, lines 6-11 of Hammond).

24. Claims 10-11, 14, and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fernberg, **Charting a course toward lower workers' comp claims** in view of Anthony, **Workers' compensation fraud** (hereinafter Anthony, paragraphs numbered by Examiner).

25. As per claim 10, Fernberg discloses the method of claim 7 as described above. Fernberg does not explicitly disclose the listed questions. Anthony discloses a method for avoiding workers' compensation fraud that includes at least asking questions about the incident that caused the injury (see paragraph 8). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the method disclosed by Fernberg. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of helping to further document inconsistencies and provide clues that could warrant a more detailed investigation (see paragraph 7 of Anthony).

26. As per claim 11, Fernberg discloses the method of claim 8 as described above. Fernberg does not explicitly disclose the listed questions. Anthony discloses a method for avoiding workers' compensation fraud that includes at least asking questions about the description of the injury (see paragraph 6). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate this feature into the method disclosed by Fernberg. One of ordinary skill in the art would have been motivated to incorporate this feature for the purpose of helping to further document inconsistencies and provide clues that could warrant a more detailed investigation (see paragraph 7 of Anthony).

27. As per claim 14, Fernberg in view of Anthony disclose the method of claim 10 as described above. In addition, claim 13 recites substantially similar additional limitations to those

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already addressed in claims 1 and 2 and, as such, is rejected for similar reasons as given above.

28. As per claim 16, Fernberg in view of Anthony disclose the method of claim 10 as described above. Fernberg further discloses closely monitoring a specific case within the workers' compensation claims management process to determine if the best practices are not being followed if the claim is classified as high risk (see paragraphs 28-30, it is noted that Fernberg discloses closely monitoring all claims and, therefore, also discloses closely monitoring "high risk" claims).

29. As per claim 17, Fernberg in view of Anthony disclose the method of claim 11 as described above. Fernberg further discloses closely monitoring a specific case within the workers' compensation claims management process to determine if the best practices are not being followed if the claim is classified as high risk (see paragraphs 28-30, it is noted that Fernberg discloses closely monitoring all claims and, therefore, also discloses closely monitoring "high risk" claims).

Conclusion

30. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Kern teaches a computerized method for supporting workers' compensation.
- Kilgour discloses examples of workers' compensation fraud in California.

31. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke Gilligan whose telephone number is (571) 272-6770. The examiner can normally be reached on Monday-Friday 8am-5:30pm.

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32. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571) 272-6776. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

33. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

8/8/05



C. Luke Gilligan
Patent Examiner
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